

Remarks/Arguments

Prior to the present amendments, claims 1-74 were pending in this application. Claims 7, 26-32, 44-49, 60-63 and 68-74 were withdrawn from consideration, claims 1-6 and 8-19 were rejected, and claims 20-25, 33-43, 50-59 and 64-67 were indicated as being objected to, although these claims were also included in the provisional obviousness-type double patenting rejections.

Claims 1-19, 26-32, 36-38, 44-49, 60-63, 66, and 68-74 have been canceled, without prejudice. Claims 20, 33-35, 39-43, 50, 52, 54, 55, and 56 have been amended. The amendments incorporate subject matter into the pending claims from claims canceled with the present amendment, and include additional changes of formal nature, and do not add new matter.

Response to Restriction and/or Election of Species

Applicants note the finality of the restriction and election of species requirements.

Information Disclosure Statement

The Examiner notes that the references listed in the specification, unless they have been cited by the examiner on the form PTO-892, have not been considered. The Examiner acknowledged, however, consideration of the references listed on the PTO-1449 forms submitted with Applicants' Information Disclosure Statements filed on January 24, 2002, July 12, 2002, and July 15, 2003.

Applicants will submit, by separate mail, a Second Supplemental Information Disclosure Statement, the consideration of which is respectfully requested.

Specification

The Examiner requested that Applicants check the specification for possible errors. Most errors identified in the specification have been corrected in the Preliminary Amendment filed on February 13, 2002, which should be of record. A further error has been corrected with the present Amendment to the Specification.

Claims Rejections - 35 U.S.C. 112, second paragraph

According to the Office Action, “Claims 1 are rejected” under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Judged by the specific reasons cited, the rejection was intended to include at least claims 1, 2, 9-14 and 50.

(a) In particular claims 1 and 50 were rejected for their recitation of “near” a site of interest. According to the rejection, the “term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.”

Applicants respectfully disagree.

Claim 1 has been canceled, but claim 20 has been modified to include a reference to residues near the site of interest. In particular, the claims recite that the TBM contains or is modified to contain a nucleophile at or “near” a site of interest.

A detailed explanation of the “site of interest” is provided on pages 31-35 of the specification. According to this teaching, the “site of interest” on a particular target, such as a Target Biological Molecule (TBM), is defined by the residues that are involved in binding of the target to a molecule with which it forms a natural complex *in vitro* or *in vivo*. In peptides, polypeptides and proteins, the site of interest is defined by the amino acid residues that participate in binding to a ligand or ligand of the target (paragraph [0065]). Directions for calculating the “site of interest” are provided in paragraphs [0066] - [0069]. The specification then explains that once the “site of interest” has been calculated, “a process of determining which amino acid residue within, or near, the site of interest to modify is undertaken” (paragraph [0070]). This is followed by an explanation of how to identify select the residues to be modified at or near the site of interest, including the teaching that the modification is generally performed within a radius of about 10 angstroms from a residues within the site of interest (paragraph [0073]). Based on these instructions those skilled in the art are reasonably apprised of the scope of the invention.

(b) Claim 1 was further rejected for insufficient antecedent basis for the recitation of “the first ligand” in step (iii).

Claim 1 has been canceled, which moots its rejection, but a similar language is now present in claim 20. The Examiner’s attention is respectfully directed to step (i), which

concludes with the formation of a TBM-first ligand complex, and step (ii), which recites the identification of the first ligand from the complex of (i). This is sufficient antecedent basis for the recitation of “the first ligand identified in (ii),” therefore, this rejection, as it may apply to claim 20, should be withdrawn.

(c) Claims 2 and 14 has been rejected for their recitation of “said ligand candidates.” According to the rejection, there was insufficient antecedent basis for this recitation in the claim, and it was not clear whether the ligand candidates referred to the “first” or the “second” ligands.

Claims 2 and 14 have been canceled, which moots their rejection.

(d) Claims 9-13 were rejected for their recitation of “said nucleophile,” which, according to the rejection, had insufficient antecedent basis. In view of the cancellation of claims 9-13, this rejection is moot.

(e) Claim 50 was rejected for its recitation of “the first ligand” in step (iii), on the ground of “insufficient antecedent basis.” Since claim 50 does not recite the phrase “the first ligand,” this rejection is believed to be in error, and should be withdrawn.

(f) Claim 50 was rejected for its recitation of “the conditions” in step (iii), which, according to the rejection, had insufficient antecedent basis. Claim 50 has been amended to make it clear that the term “the conditions” referred to the conditions under which the reagents in step (ii) were contacted with each other. The amendment is believed to obviate the reasons for rejection, which should, therefore, be withdrawn.

Claim Rejections - 35 U.S.C. 102

Claims 1-6 and 9-18 were rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Kim et al. (WO 98/22436). Without acquiescing in their rejection, and without prejudice, claims 1-6 and 9-18 have been cancelled, therefore, the present rejection is moot. Although the Examiner’s analysis includes claim 50, that claim was not rejected under this section, and was indicated as allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph.

Claim Rejections - 35 U.S.C. § 103

Claims 1-6, and 8-19 were rejected as allegedly obvious over Erlanson et al. in combination with Hajduk et al. In view of the cancellation of claims 1-6, and 9-18 this rejection is moot.

Double Patenting

Claims 1-6, 8-25, 33-43, 50-59 and 64-67 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-39 of U.S. Patent Application Publication 2003/0104471 A1.

Claims 1-6, 8-25, 33-43, 50-59 and 64-67 were further provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-39 of U.S. Patent Application Publication 2002/0081621 A1.

Finally, claims 1-6, 8-25, 33-43, 50-59 and 64-67 were provisionally rejected under the judicially created obviousness-type double patenting over claims 1-39 of U.S. Patent Application Publication 2002/0022233 A1.

Without acquiescing to the present rejections, applicants believe that all other rejections have been overcome by the foregoing arguments and arguments. Accordingly, even if the present rejection is maintained, it should be withdrawn in the present application, and repeated in one or both of the pending parallel applications, where it can be properly addressed.

The Examiner's attention is respectfully directed to M.P.E.P. 804 I.B. which, in its relevant part, states:

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent. (Emphasis added.)

All claims pending in this application are believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited. Should the Examiner find

that there are any more issues outstanding, he is respectfully requested to contact the undersigned attorney at the telephone number shown below, to arrange a telephonic or personal interview.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641 (Attorney Docket No.: 39750-0001A. Please direct any calls in connection with this application to the undersigned at the number provided below.

Respectfully submitted,

Date: October 22, 2004



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